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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,878	09/11/2003	Kevin J. Zilka	SVIPGP002B	8771

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,878

Applicant(s)

ZILKA ET AL.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 18-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on November 2, 2004, wherein:

Claims 1-13 and 18-43 are currently pending;

Claims 14-17 have been cancelled;

Claims 1-6 and 18-19 have been amended;

Claims 20-43 have been added.

Information Disclosure Statement

2. The information disclosure statement filed December 24, 2004 has not been considered by the Examiner since it is unavailable to the Examiner at the time of this Office Action. Although the IFW shows receipt of the IDS, the IDS nor the references have been scanned into the system so as to be available to the Examiner.

The information disclosure statement (IDS) submitted on May 19, 2004 is being considered by the examiner.

Response to Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 and 18-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has added significant language to the claims which, instead of clarifying the claims, has made them more unclear.

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The following claim language is unclear:

By providing a correspondence between the file and the at least one identifier, *thus associating the manually selected file with the at least one identifier*, (this language adds little, if anything, to the first half of the claim language, wherein a manually selected *first file is capable of* being associated with a *first identifier* corresponding to a single patent, and a manually selected *second file is capable of* being associated with a *second identifier* corresponding to a group involving a plurality of patents, and associating a plurality of patents with the at least one identifier. The terminology “is capable of” renders the claim language indefinite.

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant lists the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier.

The applicant then adds the language “wherein the manually entered notes at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. What does the applicant mean by accessible?”

The applicant then has added the language that “wherein a set of patents *is capable of* being *reported* by – what does the applicant mean by “reported.” The term “is capable of” renders the claim language indefinite.

The applicant states in the claim language “that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail”. This is unclear. What does the applicant mean by “made accessible?”

The language "wherein the at least one identifier is determined by adding the at least one identifier by entering the at least one identifier" is unclear.

The language "wherein the patents are associated manually" and "wherein the patents are manually entered via a registration interface" is unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 and 19-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, as to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter

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to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, the applicant states that it is a method utilizing a computer-implemented system. The body of the claim language has a wherein clause which states that wherein said method, at least in part, is carried out utilizing the computer-implemented system.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 18-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (US 2002/0046307) (hereinafter referred to as Rivette).

Rivette discloses a method and software (page 9 [0289-0291] page 10 [0294] for organizing patents comprising:

displaying (display unit (1122) page 9 [0292]) a notes filed for receiving manually entered notes (Fig. 4 Notes Mode (414) Fig. 2 page 7 [0255-0257] Figs. 125-143] including text (page 11[0314]));

storing the manually entered notes in association with at least one identifier (Fig. 127 (12612) (it is inherent that an identifier is stored with notes stored in a database);

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allowing the manual selection of a file (page 15 [0373], page 15 [0383]);

storing the manually selected file in association with the at least one identifier by

providing a correspondence between the file and the at least one identifier (page 12 [0327-0329],

wherein a manually selected first file is capable of being associated with a first identifier

corresponding to a single patent and a manually selected second file is capable of being

associated with a second identifier corresponding to a group (Fig. 12B-12C involving a plurality

of patents (page 2 [0023] page 7 [0264], page 8 [0265] page 10[0303], page 15 [0385-0386])

(Fig. 4, Fig. 6 – Document databases, Notes databases), Fig. 7); and

associating a plurality of patents with the at least one identifier (page 7-8 [0264-0265]);

wherein the manually entered notes and the patents are accessible by subsequent selection

of the at least one identified (page 12 [0327-0329], Figs. 111-112)

wherein a set of patents is capable of being reported by;

displaying a technology mapping depicting at least one category of technology utilizing a

graphical user interface (page 2 [0025], page 7 [0262], pages 8-9 [0277]),

displaying statistics regarding a number of the patents of the set in each category of

technology (page 2 [0025], page 7 [0262], pages 8-9 [0277]),

displaying first additional information associated with at least a portion of the patents of

the set upon the selection of an icon (Fig. 153),

wherein the first additional information includes a list of patents of the set associated with

one category of technology (page 12 [0331]),

displaying additional information associated with at least one of the patents of the list

upon the selection of an additional icon, wherein the second additional information is selected

from a group consisting of a patent number, status, an exemplary claim, and an exemplary figure (page 15 [0377], Fig. 7, Fig. 45 (4512), Figs. 111-112),

wherein the statistics are displayed in a first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface (Fig. 112);.

wherein said method is at least in part carried out utilizing the computer implemented system (Fig. 3-4).

Rivette does display interfaces showing different information (Figs. 57, 125). However, Rivette does not explicitly disclose displaying a technology mapping (although page 2 [0025] does not exclude technology mapping) depicting at least one category of technology or wherein the first additional information includes a list of patents of the set associated with one category of technology, or wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface or wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

The fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known. Furthermore, because of the way this step is worded, it could encompass a person emailing another person to come look at the notes and files.

Rivette discloses a method wherein the at least one identifier is determined by selecting an already existing identifier (Fig. 12 F (Foreign Patent No. would be an already existing identifier.)

It is old and well known to have a method wherein the at least one identifier is determined by selecting an already existing identifier utilizing a pull-down menu. For example, while doing a search in East, the Examiner may use a number for a pull down menu to select a search and then store this search as a new search.

It is also old and well known to add a file and thus create a new file with a new identifier or modify the name to a file thus creating a new identifier.

Rivette discloses wherein a notes field allows a user to cut and paste notes (Fig. 58, Fig. 137 (Note ToolBar (13706))), wherein the file is selected utilizing a file structure field (Fig. 58), wherein the file structure field includes a file tree structure (Fig. 58), wherein the file structure field allows a user to browse various folders where files have been previously stored, Fig. 58),

and wherein the file structure is displayed simultaneously with the notes filed on the same interface (Fig. 58).

Rivette discloses wherein the patents associated with the at one identifier are identified by searching a database of already existing identifiers (Fig. 6, Figs. 12B—12L).

Rivette discloses wherein the database is a comprehensive database of all patents issued by at least one government agency (Document database [0310-0311], Patent bibliographic database {0318-0322})

Rivette discloses wherein a search is capable of being performed in association with at least one of the patents using at least one synonym (Fig. 53-57 (Rivette discloses use of a thesaurus):

identifying at least one claim associated with at least one of the patents (Fig. 22-25,
extracting a plurality of terms from the patent (Fig. 22-25),
identifying at least one synonym associated with at least one of the terms (Figs. 22-25),
and
conducting a search utilizing the terms and the at least one synonym (Figs. 22-25);

Rivette discloses wherein the statistics are represented via at least one bar graph (Fig. 66).

Rivette discloses wherein the patents are associated with one particular corporate entity (page 7 [0264], page 10[0195-0302] Customer Corporate Entity, page 13 [0349]).

Rivette does not disclose a method wherein the word "claim" is removed from the terms of the claim of the patent. However, would be obvious to one of ordinary skill in the art to remove the word claim from the search terms since the word claim is in each patent application. The Examiner tries not to use the word "patent" as a search term even though the Examiner examines and searches patent prosecution methods and systems due to the large number of results retrieved due to this word.

Rivette discloses wherein the patents are extracted from a database including a comprehensive set of intellectual property identifiers associated with at least one governmental authority (Patent Number, Patent Bibliographic database [0321]).

Rivette discloses wherein the terms of the claim are automatically retrieved from a database (page 16, [0395]).

Rivette discloses wherein noun terms of the claim are identified (page 16 [0395], Figs. 22-24)

Rivette does not disclose wherein verb terms of the claim are identified. However, Rivette discloses word searches and it is easy to incorporate verb terms into a search (page 16

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[0395]). For example, while searching patent prosecution, the Examiner may use the term prosecut\$6.

Rivette discloses wherein Boolean searching is incorporated with the searching based on the terms of the claim of the patent and the synonym(page 16 [0395 – thesaurus, key phrases with Boolean], page 17 Table 2).

Rivette discloses wherein AND operators are incorporated with the terms of the claim of the patent and the at least synonym (page 16 [0395], page 17 Table 2).

Rivette discloses wherein a plurality of the synonyms are identified based on the terms of the claim of the patent, utilizing a synonym database (page 16 [0395-thesaurus]).

Rivette discloses wherein the synonyms are incorporated with the terms of the claim of the patent to increase the breadth of the search (page 16 [0395-0397]).

Rivette discloses wherein the synonyms are incorporated with the terms of the claim of the patent utilizing an OR operator (page 16 [0395], page 17 Table 2).

Rivette discloses wherein the search is conducted manually upon receiving a user request (Searching Module-pages 16-20 [0388-0444]).

Rivette discloses wherein the search is conducted automatically at predetermined intervals (page 10-11 [0308], page 18 see Automatic Searches Related to Groups {0418}).

Rivette discloses wherein the terms are modified based on results of the search. (page 16 [0394]). Furthermore, this it is old and well known to modify terms based on search results.

Rivette discloses wherein the terms are modified based on results of the search and user input (page 16 [0394]).

Rivette discloses wherein the terms are modified based on results of the search automatically (pages 16-20 [0388-0444]).

Response to Arguments

Applicant's arguments filed on November 2, 2004 have been fully considered but they are not persuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The applicant's main argument is that Rivette does not disclose manually entering notes and having the notes associated with at least one identifier. The Examiner directs the applicant to page 12 Notes Database which states in section [0327] that "the present invention allows users to create and link annotations (also called notes) to any portions of the documents in the

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document database (612). Such annotations can include text, graphics images, video, audio, and/or any other information representation that can be stored in electronic form.” See also Figures 125 ((12520) and 134. See Fig. 117 (Document Toolbar and Note Toolbar all associated with one identifier Document #)


Rivette also discloses associating a plurality of patents with the at least one identifier (See page 7 [0264])

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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